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JUN 02 2006
Director's Office
Group 3700

In re Application of: MASSOKA et al.
Appl. No.: 10/605,843
Filed: October 30, 2003
For: KICKBACK PREVENTING CIRCUIT
FOR ENGINE

DECISION ON PETITION


This is a decision on the petition filed on October 14, 2005 by which petitioners request entry of the amendment submitted after final rejection September 29, 2005. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is dismissed.

Review of the prosecution history shows that the examiner promulgated a final rejection on September 22, 2005. On September 29, 2005 petitioner submitted an amendment proposing to add a claim copied from US Patent 6,786,212 for the purpose of provoking interference. On October 10, 2005 the examiner promulgated an advisory action indicating the proposed amendment would not be entered as it at least raised a new issue. On October 14, 2005 petitioner filed a petition requesting supervisory review of the examiners decision in light of petitioner's arguments and relief in directing the entry of the copied claim into the application for the purpose of interference.

Petitioner supports his position by arguing a distinction between the filing of a claim in response to a final rejection as opposed to filing a claim intentioned to provoke an interference proceeding. Petitioner admits recognition of the interfering subject matter "shortly" after the filing of the amendment on March 20, 2005 but failed to present the copied claim until September 29, 2005. Petitioner opines the paper was marked that it was not intended to be a reply to the final Office action, and that it is not believed the Rules or Statute prohibit copying a claim for the purpose of interference after the issuance of a final rejection.

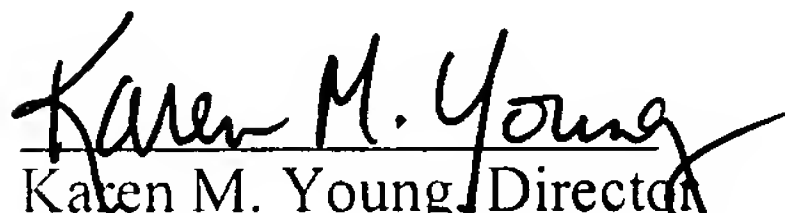
37 CFR 1.113 and 37 CFR 1.116 proscribe the requirements for filing of an amendment after final rejection. As is clearly outlined in MPEP 714.13, entry of claims after close of prosecution is not a matter of right. Amendments filed after final rejection are limited by 37 CFR 1.116. It is the combination of amendment timeliness and amendment content with respect to the status of prosecution that determines amendment entry after close of prosecution. Entry is not determined by the petitioner's intent. The proposed addition of a copied claim for interference clearly does



raise new issues in as much as all claims in an application must be fully examined. An applicant is not entitled to an interference proceeding just because a claim has been copied. A claim to conflicting subject matter must also be patentable to the applicant who copied the claim and such may only be determined by examination on the merits. See MPEP Chapter 2300. As such, the refusal of amendment entry by the examiner appears well within proper interpretation of the rules of practice. Therefore the refusal of entry of the September 29, 2005 amendment is not in error and no basis for granting the relief petitioner requests is apparent.

Finally, it is noted the copied claim submitted on September 29, 2005 included a "Request for Interference" submitted under 37 CFR 1.604. This rule was removed and restated in 37 CFR 41.202 on September 13, 2004. Even though the copied claim has not been entered after close of prosecution of the instant file, the date of filing of the copied claim does serve as an evidentiary consideration for the requirement of timely presentation of copied claims as is proscribed by 35 USC 135 (b)(1) for any possible future requests for interference should prosecution of the instant file be reopened or should a continuation application be filed by petitioner. Petitioner's attention is directed to MPEP 2304.02(c), section II (October 2005) in particular. Should petitioner have further questions, he is invited to contact TC 3700 SPRE/Interference Practice Specialist Jessica Harrison at 571-272-4449.

PETITION DISMISSED


Karen M. Young, Director
Technology Center 3700